

**AMENDMENT TRANSMITTAL LETTER**Docket No.
SEDERM 3.3-009Application No.
10/519,118-Conf. #9458Filing Date
September 29, 2005Examiner
B. M. GullledgeArt Unit
1619

Applicant(s): Karl Lintner

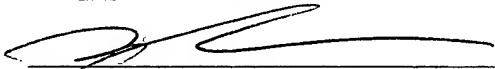
Invention: COSMETIC OR DERMOPHARMACEUTICAL COMPOSITIONS COMPRISING TYRAMINE
DERIVATIVES, METHOD FOR PREPARING SAME, AND USE THEREOF**TO THE COMMISSIONER FOR PATENTS**

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED

	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
Total Claims	25	- 27 =		x	
Independent Claims	2	- 3 =		x	
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify):					
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:					

☒ Large Entity☐ Small Entity☐ No additional fee is required for this amendment.☐ Please charge Deposit Account No. _____ in the amount of \$ _____.☐ A check in the amount of \$ _____ to cover the filing fee is enclosed.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized to charge and credit Deposit Account No. 12-1095
as described below. A duplicate copy of this sheet is enclosed.☒ Credit any overpayment.☒ Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.
Michael H. Teschner
Attorney/Agent Reg. No.: 32,862Dated: February 10, 2009LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 10, 2009

Signature:  (Michael H. Teschner)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: February 10, 2009

Signature:

(Michael H. Teschner)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Karl Lintner

Application No.: 10/519,118

Group Art Unit: 1619

Filed: September 29, 2005

Examiner: B. M. Gulledge

For: COSMETIC OR DERMOPHARMACEUTICAL
COMPOSITIONS COMPRISING TYRAMINE
DERIVATIVES, METHOD FOR
PREPARING SAME, AND USE THEREOF

**AMENDMENT IN RESPONSE TO RESTRICTION REQUIREMENT AND
ELECTION OF SPECIES**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This communication is in response to the Office Action mailed December 11, 2008, setting forth a Restriction Requirement and a Requirement for Election of Species in the above-identified application. Claims 18-43 remain pending in the application. Claims 18, 30, 33, 36, and 37 are amended to delete "sulfonyl." In addition, claims 33 and 37 are amended to delete "sulfonic." Claim 38 is amended to delete the compound of formula III. Claim 23 has been canceled. No new matter has been added by way of this amendment. Accordingly, entry of the present amendment is respectfully requested.

In the Office Action, the Examiner required restriction to one of the following inventions pursuant to 35 U.S.C. §§ 121 and 372:

Group I, claims 18-29 and 38-41, drawn to a dermatopharmaceutical formulation.

Group II, claims 30-37, drawn to a method of making a dermatopharmaceutical formulation.

Group III, claims 42-43, drawing to the use of a dermatopharmaceutical formulation.

In addition, if the Applicant elected Group I or Group II, the Examiner required that Applicant elect a particular species of the compound of formula I to which the claims shall be restricted if no generic claim is finally held to be allowable.

In response, Applicant asserts that in view of the current amendment this restriction for lack of unity is improper in accordance with the decision in Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590 (E.D. Va. 1986). Indeed,

"when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111".

Here, it is Applicant's position that there is unity of invention and that the restriction and the election are improper. Pursuant to 37 C.F.R. § 1.475, a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to a product (i.e., the invention of Group I),

a process specially adapted for the manufacture of said product (*i.e.*, Group II), and a use of said product (*i.e.*, Group III). Moreover, claim 18 recites a composition which is a common technical feature linking each of the pending claims 19-22 and 24-43 with claim 18. Furthermore, this common technical feature is neither anticipated nor rendered obvious by *Witte et al.*, (U.S. Patent 4,258,058), which does not disclose the dermatopharmaceutical formulations, methods of making, or methods of using the claimed formulations.

In the alternative, however, Applicants would elect the invention of Group I. Of the species identified by the Examiner, Applicant would elect octopamine, wherein X is $-NR^3R^4$; R^1 is an alcohol; and R^2 , R^3 and R^4 are hydrogen atoms. Claims 18-21, 25-29, 38-39, and 41 read on the elected species. However, this election is made with traverse, as the respective searches appear to be substantially coextensive for each of Groups I-III.

Moreover, in addition to unity of invention and a common technical feature, notwithstanding the different classifications of the claims of Groups I-III, the "inventions" in these groups are related. Therefore, it is respectfully submitted that a search for one "invention" will necessarily involve a search for the other as well. In accordance with the policies outlined in the Manual of Patent Examining Procedure, where possible, a search of all "inventions" should be made together. It is respectfully submitted that doing so in this instance will not be unduly burdensome. Reconsideration of the requirement and examination of all the claims are therefore respectfully requested and considered to be appropriate in this case. If, however, for any reason the Examiner does not believe that such action can be taken at this time, the Examiner is invited to telephone the undersigned at 908-654-5000 so as to

overcome any additional objections.

In the event the request to examine all the claims together is not granted, Applicants reserve the right to file a divisional application corresponding to the non-elected claims.